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Paper Number 14

In re application of :  
Michael Backer et al. :  
Serial No. 09/914,156 : DECISION ON  
Filed: December 12, 2001 : PETITION  
For: METHOD FOR COATING A SEMICONDUCTOR MATERIAL USING :  
HIGH REMANENT INDUCTION, COATED SEMICONDUCTOR :  
MATERIAL AND USE THEREOF :

This is a decision on the PETITION FOR WITHDRAWAL OF NON-UNITY OF INVENTION, filed June 30, 2003, which requests withdrawal of the lack of unity of inventions requirement set forth in the examiner's Office actions of Paper Nos. 8 (November 18, 2002) and 12 (June 13, 2003). In the Office action of November 18, 2002, the examiner made a three-way restriction requirement under 37 CFR 1.499. The basis of this holding of lack of unity of inventions was that the Groups lack the same or corresponding special technical feature, namely the specific magnetic property of the product of Group II. The applicant provisionally elected the product claims of Group II (claims 18-23). The applicant traversed this requirement in the response of April 18, 2003 on two grounds. First, the applicant argued that the claims of Group II are dependent upon a claim contained in Group I. Second, the applicant argued that Groups I and III should be rejoined according to the provisions of MPEP 821.04. The examiner rejected the first argument by maintaining the position that the claims of Group I do not require the specific magnetic property found in Group II. The examiner failed to respond to the second argument. The present petition further includes the argument that the present scenario is "*exactly*" the situation detailed in Example 1 of Annex B Part 2 of the PCT Administrative Instructions contained in Appendix AI of the MPEP.

### DECISION

Regarding the first argument, which was contained in the unity of inventions traversal of April 18, 2003, Annex B, Part 1, Section (c), defines a "dependent" claim as a claim which contains all of the features of another claim and is in the same category of claim as the other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.). As set forth in the original holding of lack of unity of inventions, the claims of Group II are drawn to a distinct "category" of claims, namely a product, whereas Groups I and III are drawn to a process of manufacturing and process of using, respectively. Accordingly, this argument is not persuasive.

Regarding the second argument, which was contained in the unity of inventions traversal of April 18, 2003, MPEP 821.04 states that if the applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. A

review of all of the non-elected claims reveals only non-elected claim 25 is depend from or otherwise include all the limitations of the allowable product claim. Accordingly, the examiner erred by not rejoining claim 25 in the last Office action. However, none of claims 1-17, 24 or 35-42 include the magnetic property limitation of "a maximum value of remanent induction at 77 K and 0 T of at least 1100 mT." Thus, claims 1-17, 24 and 35-42 are not in condition for rejoinder.

Regarding the third argument, which was contained in the Petition of June 30, 2003, contrary to the petitioner's statement Example 1 (Annex B, Part 2, PCT Administrative Instructions) is not the same exact situation of the present application. Example 1 includes claim 1 directed to a method of manufacturing chemical substance X, claim 2 directed to substance X and claim 3 directed to the use of substance X. It is stated in Example 1 that unity exists between claims 1, 2 and 3, because the special technical feature common to all the claims is substance X. The claims of the present application includes Group I (claims 1-17 and 35-42) directed to a process of manufacturing X, Group II (claims 18-23 and 26-34) directed to substance X' and Group III (claims 24 and 25) directed to the use of substance X (for claim 24) and X' (for claim 25). As detailed in the original holding of lack of unity of inventions, substance X and substance X' are two distinct special technical features. Thus, the examiner holding of lack of unity of inventions is deemed to be proper, except for claim 25, which includes the special technical feature of Group II, i.e. substance X'.

The Petition is **Granted-in-part**. Claim 25 is deemed to be in condition for rejoinder and shares the special technical feature of the elected product claims. However, claims 1-17, 24 and 35-42 are not in condition for rejoinder and do not share the special technical feature of the elected product claims. Accordingly, the Petition is denied regarding these claims. The Office action mailed on June 13, 2003 is hereby vacated, and the application file returned to the examiner for prompt preparation of a supplemental Office action, which rejoins claim 25, i.e. form paragraph 8.42. An Office action shall follow in due course.



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